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REMARKS

AUG 09 2006

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow Claims 14-27, the only claims pending and currently under examination in this application.

FORMAL MATTERS

Claims 14-27 were examined and rejected.

Claim 14 has been amended to specify that the second layer is held in radial tension between 5 and 1000 newton/m. Claim 16 has been amended to specify that the second and third layers are held in radial tension between 5 and 1000 newton/m. Support for this amendment may be found in original Claim 20.

Claim 20 has been amended to depend from Claim 14 and to specify that the first layer is held in a compression of between 5 to 1000 newton/m. Support for this amendment may be found in original Claim 25.

Claim 24 has been amended to correct a typographical error.

As the above amendments enter no new matter to the application, their entry by the Examiner is respectfully requested.

REJECTION UNDER 35 U.S.C. § 102

Claims 14 and 15 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Maronian et al. (U.S. Patent No. 5,059,486).

According to MPEP § 2131, a claim is anticipated by a reference only if the reference teaches each and every element of the claim.

Independent Claim 14 and dependent Claim 15 are drawn to methods of fabricating a septum in which the second layer is held under radial tension between 5 and 1000 newton/m.

However, Maronian et al. describes a multilayered rubber article in which the base layer is initially stretched before applying an intimately adhered overlayer of elastomeric material. Maronian et al. specifically teaches that "the resulting article is permitted to elastically contract to a more relaxed state." (col. 2, line 19).

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As such, the Applicant submits that Maronian's rubber article is not "held" under radial tension as in the present claims.

In maintaining the rejection, the Examiner states that "when one reads the reference to Maronian et al. as a whole one readily would have understood that the layer 10 remained in tension while the layer 12 was in compression subsequent to the bonding of the layers" (Office Action, p. 2).

Furthermore, in response to the previously submitted arguments, the Examiner stated the following:

Note that all tension is not removed as discussed at column 2, lines 23-29 of the reference. The applicant is advised that the presented limitation is not as limiting as applicant argues, i.e., the claims are not commensurate in scope with the applicant's arguments. To begin with the presented requirement that the layer is kept under tension does not define when it is kept under tension. Additionally, the degree of tension that is kept in the layer is not defined in such a way as to define over Maronian et al. (Office Action, p. 4).

However, the instant specification clearly teaches that tension may be applied prior to or after bonding the second layer to the first layer (as well as the third layer when present) and that such tension is continuous (P. 2, line 19 to P. 3, line 11). As such, one of skill in the art from reading the instant specification would fully understand that once the tension is applied, the layer is continuously under tension. Therefore, the Applicant submits that the skilled artisan would realize when the layer is kept under tension from reading the detailed description.

Furthermore, the claims have been amended to specify that the second layer (Claim 14) and third layer (Claim 16) are held under radial tension between 5 and 1000 newton/m. The Applicant submits that nowhere in the disclosure does Maronian teach the element of radial tension between 5 and 1000 newton/m. As such, in contrast to the Examiner's assertion above, the degree of tension that is kept in the layer is defined over Maronian et al.

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Therefore, Maronian et al. fails to anticipate the present claims because the reference does not teach each and every element of the present invention. In view of the foregoing discussion, this rejection may be withdrawn.

REJECTION UNDER 35 U.S.C. § 103

In the Office Action, Claims 14-27 have been rejected under 35 U.S.C. § 103(a) as being obvious over the assertedly admitted prior art or McKinney (U.S. Patent No. 3,551,273) in view of Maronian et al. (U.S. Patent No. 5,059,486) and Jacobs (U.S. Patent No. 3,857,751).

With respect to rejections made under 35 U.S.C. § 103, MPEP § 2142 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [emphasis added]

The instant claims are drawn to methods of fabricating a septum in which the second layer (Claim 14) and third layer (Claim 16) of the septum are held under radial tension between 5 and 1000 newton/m.

As stated in the previous response, McKinney and the assertedly admitted prior art disclose septums having three layers, namely, a central rubber layer and two exterior rubber layers which are bonded together. However, nowhere in the disclosure does the McKinney reference and the assertedly admitted prior art fail to teach or suggest a septum having second and third layers which are held under

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radial tension between 5 and 1000 newton/m as in the present invention.

In maintaining the rejection, the Examiner continues to rely on Maronian to provide the element of a septum having a layer under tension. However, as discussed above, Maronian fails to teach or suggest the element of the element of radial tension, between 5 and 1000 newton/m. Therefore, Maronian fails to make up for the deficiency of the assertedly admitted prior art or McKinney.

Additionally, the Jacobs reference was cited for teaching that tension layers were put in tension during the bonding operation (Office Action dated 2-24-06, p. 4).

However, nowhere in the reference does Jacobs teach or suggest a septum having second and third layers which are held under radial tension, between 5 and 1000 newton/m as in the present invention. As such, the reference fails to make up for the deficiency of the admitted prior art, McKinney and Maronian et al.

Therefore, Claims 14-27 are not obvious under 35 U.S.C. § 103(a) over the admitted prior art or McKinney (U.S. Patent No. 3,551,273) in view of Maronian et al. (U.S. Patent No. 5,059,486) and Jacobs (U.S. Patent No. 3,857,751). Accordingly, this rejection may be withdrawn.

REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 24 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

In view of the above amendment, this rejection may be withdrawn.

RESPONSE TO EXAMINER'S COMMENTS

In the Office Action, the Examiner alleges that "It should be noted that the applicant did not expressly address the specific dependent claims and thus applicant

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is advised that he has acquiesced to the same. Namely, the various means to place the elastomeric material into compression as well as tension were taken as conventional to the art and one skilled in the art would have been expected to select from the commercially and well known ways to achieve the same." (Office Action p. 6)

The Applicant submits that no admissions have been made and traverses the allegations made by the Examiner with respect to Claims 17, 19 and 20 -26 in the Office Action dated February 24, 2006. In particular, the Applicant traverses the Examiner's assertion that the use of thermal shrinkage as an alternative to stretching is taken as well known and conventional and would have been viewed as an alternative technique in the art.

The MPEP 2144.03 specifically provides that the examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art.

According to the Office Action dated February 24, 2006, the Examiner rejected the dependent claims by stating the following:

Regarding Claim 19, one skilled in the art would have understood that the thermal shrinking was a well known equivalent to provision of prestressing in the art of elastomeric materials (for example in the art of elastics it was well known to apply the elastics in a tensioned state or to apply in an untensioned state and follow this with thermal shrinkage to render the elastics elastic in the finished assembly.) The use of thermal shrinkage as an alternative to stretching is taken as well known and conventional and would have been viewed as an alternative technique in the art. (Office Action, p. 5)

As such, the Examiner rejected the dependent claims (Claims 17, 19 and 20 - 26) in view of a method of applying tension which allegedly is common knowledge in the art.

Firstly, the Applicant requests that the Examiner submit an affidavit under 1.104(d)(2) providing support which demonstrates that thermal shrinkage as an alternative to stretching is common knowledge in the art.

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Secondly, the Applicant submits that none of the references cited by the Examiner teach a method of thermal shrinking as an alternative to stretching. Maronian et al. specifically teaches initially stretching a base layer before applying an intimately adhered overlayer of elastomeric material. Additionally, Jacobs discloses a composite sheet formed from three layers of elastomeric sheet material bonded together with intervening layers of a woven, mesh-like material held in a resiliently pre-stressed tensile condition.

The Applicant contends that if the use of thermal shrinking as an alternative to stretching was so well known in the art, either Jacobs or Maronian should have at least described the method in some form of embodiment. As such, the Examiner has failed to unquestionably demonstrate the use of thermal shrinking as being "well-known" in the art.

In view of the foregoing discussion, the Applicant submits that the Examiner's reliance on common knowledge in the art for teaching use of thermal shrinking as an alternative to stretching is improper.

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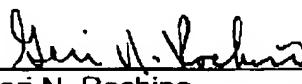
CONCLUSION

In view of the amendments and remarks above, the Applicant respectfully submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone John Brady at 408- 553-3584.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078, order number 10004031-2.

Respectfully submitted,

Date: August 9, 2006

By: 
Geri N. Rochino
Registration No. 58,147

Date: August 9, 2006

By: 
Bret E. Field
Registration No. 37,620

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, Colorado 80537-0599

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